

Application No.: 10/015,436

Docket No.: 64392-0080

REMARKS

Applicants have carefully reviewed the Final Office action mailed March 24, 2004 (paper no. 8) and thank Examiner Tran for the detailed review of the pending claims. Claims 1, 3-15, 19 and 21 were rejected in the Office action. In response to the Final Office action, previously withdrawn claims 16-18, 20 and 22-28, are now canceled. Further, claims 1 and 21 have been amended, claims 29-30 have been added, and claim 3 has been canceled. In view of the amendments and new claims, no new matter has been added. Accordingly, claims 1, 4-15, 19, 21 and 29-30 are pending in this application. Applicants respectfully request reconsideration of the present application in view of the above amendments and the following remarks.

I. Election/Restrictions

By this Amendment, Applicants cancel Claims 16-18, 20 and 22-28 as being drawn to a non-elected invention.

II. Claim Rejections Under 35 U.S.C. §103

Claims 1, 3-15, 19 and 21 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over Hellenkamp et al. (U.S. Patent No. 5,822,927) in view of Presto (U.S. Patent No. 4,328,642). The rejection is respectfully traversed.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness. "To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

In the present case, there is no motivation to combine the Hellenkamp and Presto patents to result in the claimed invention having the inner panel, the outer panel and the support structure each comprised of plastic. Hellenkamp teaches an outer panel made of an aluminum alloy while Presto teaches inner and outer panels with a metal support structure. The Examiner attempts to combine the teachings of Presto with Hellenkamp to result in the claimed invention of a structural panel comprised of plastic. However, the Presto patent teaches away from having

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a structural panel comprised of plastic. Specifically, Column 1, lines 7-8 teaches that making doors completely out of plastic is desirable, but impractical.

A prior art reference may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Thus, Applicants submit that a person of ordinary skill in the art, upon reading the Presto patent, would be discouraged from using plastic for the inner panel, support structure and outer panel.

The Examiner argues that in combining references there is no requirement that the secondary reference, i.e. Presto, be bodily incorporated into the structure of the primary reference in order for the combination to be considered proper. (See Final Office action, page 3.) However, according to *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241 (Fed. Cir. 1986), prior art references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. Further, the Court in *Akzo* continued by stating that appellants cannot pick and choose among individual parts of assorted prior art references as a "mosaic to recreate a facsimile of the claimed invention." The Examiner is attempting to do exactly what the Court said must not happen. The Examiner is simply applying the Presto patent to teach an outer panel made of plastic, while ignoring remaining portions of the patent, specifically, the teaching in Presto that it would be impracticable to have a door made completely out of plastic. Thus, one skilled in the art at the time of the invention would not have any motivation after reviewing the Presto patent to develop a door with the inner panel, the outer panel and the support structure each made of plastic. Hence, there is no motivation or suggestion to combine the Hellenkamp and Presto patents and for at least this reason the claims are patentable.

Additionally, remaining claims 4-15 and 19 are dependent claims adding features to the patentable independent claims. For at least this reason they are also patentable. Accordingly, all of the claims presently pending are patentable and the Applicants respectfully request allowance of claims 1, 4-15, 19 and 21.

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New Claims

The Applicants have added claims 29 and 30. The claims are added to further define patentable subject matter of the claimed invention. Specifically, each claim includes the patentable feature of the support structure connected to only one of the inner or outer panels. This patentable feature is not shown in the prior art. The prior art does teach support structures connected to two panels, typically an inner panel and an outer panel, but the claimed invention is an improvement over the prior art. The claimed invention provides the all plastic support structure connected to only one panel while still providing the necessary rigidity typically required in a structural panel. Further, the claimed invention includes a second panel, but the second panel is merely decorative and is easily replaced when the structural panel is damaged, such as in an automobile accident. Accordingly, for at least these reasons the new claims are also patentable and the Applicants respectfully request their allowance.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 64392-0080 from which the undersigned is authorized to draw.

Respectfully submitted,

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